REMARKS/ARGUMENTS

In order to hasten the prosecution of the present application, the present Amendment incorporates features indicated as being allowable in the pending Office Action, reserving the right to amend the claims back to their originally filed form in the event that the present application is not allowed.

Claims 1, 3, 5-10, 12, and 14-18 are pending in this application. Claims 9 and 18 have been currently amended. Support for the amendment may be found throughout the specification and drawings.

Floppy Disk

Per the Patent Office's request, Applicant has enclosed a floppy disk containing all pending claims along with Applicant's responsive remarks. Applicant understands that only the paper copy will be entered.

Allowable Subject Matter

The Patent Office has indicated that original Claims 9 and 18 "would be allowable if rewritten in independent form including all of the limitations of each claims respective base claim and any intervening claims" (Office Action, Pages 2). Applicant has rewritten these claims in accordance with the Patent Office's instruction. Thus, Claims 9 and 18 should be allowed.

Title

Please amend the title to "A METHOD AND SYSTEM FOR PROVIDING DISTRIBUTED FUNCTIONALITY OVER A NETWORK".

Claim Rejections – 35 USC § 103(a)

Claims 1, 3, 5-6, 10, 12 and 14-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nessett et al. ("Nessett", U.S. Patent No. 5,727,145) in view of Rangarajan et al. ("Rangarajan", U.S. Patent No. 6,185,609). Claims 7-8 and 16-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nessett in view of the APA. Applicant respectfully traverses this rejection.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Independent Claims 1 and 10 each recite a limitation of "wherein the architecture administrator only controls launch of the first program object and the second program object" (emphasis added).

In rejecting original Claims 1 and 10, the Patent Office has analogized "JMA dispatcher 221" of Rangarajan to the "architecture administrator" as claimed in Claims 1 and 10. As indicated in Rangarajan, "[t]he JMA dispatcher 221 is an object factory that creates a server object in the server 203 for each registered client" (col. 7, ll. 3-4). However, Rangarajan fails to teach, disclose, or suggest that the JMA dispatcher 221 only controls launch of the first program object and the second program object and has no further involvement in a transaction between the first program object and the second program object once the first program object and the second program object are lunched. Thus, Rangarajan fails to teach, disclose, or suggest the above indicated limitation in Claims 1 and 10. Thus, Claims 1 and 10 are non-obvious and should be allowed.

Claims 3 and 5-8 depend from Claim 1 and are therefore non-obvious due to their dependence. Claims 12 and 14-17 depend from Claim 10 and are therefore non-obvious due to their dependence. Accordingly, the rejection should be withdrawn, and Claims 3, 5-8, 12, and 14-17 should be allowed.

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nessett in view of the APA. However, as admitted by the Patent Office, "Nessett does not explicitly disclose the additional limitations" of "the architecture administrator only controls launch of the first program object and the second program object" as claimed in Claim 1 (Office Action, page 3). Because neither Nessett nor the APA teaches, discloses, or suggests "the architecture administrator only controls

launch of the first program object and the second program object" included in Claim 7 (because Claim 7 depends from Claim 1), Claim 7 is non-obvious and should be allowed.

Furthermore, as the Patent Office is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.,* 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Patent Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. .... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (emphasis added) *In re Oetiker,* 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine,* 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

Dependent Claim 7 recites a "transaction object suitable for supplying billing information related to the performed task." Even though the Patent Office's allegation that the APA teaches billing information and that Nessett teaches a transaction object were true, the Patent Office still fails to provide the required motivation to combine the APA with Nessett absent the present application. Thus, in rejecting Claim 7, the Patent Office has selected portions from two references (i.e., Nessett and the APA) to arrive at the present invention, in which, none of the references supply the motivation for the additional reference as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully

submitted that a *prima facie* case of obviousness for Claim 7 has not been established. Therefore, Claim 7 should be allowed.

Claim 8 depends from Claim 7 and is therefore allowable due to its dependence.

Claims 16-17 were rejected based on the same rational as applied to Claims 7-8 and are therefore also allowable since Claims 7-8 are allowable.

CONCLUSION

In light of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in the case.

Respectfully submitted on behalf of

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